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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,921	07/28/2003	Steven M.H. Wallman	10392/460044	3612

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EXAMINER

MEINECKE DIAZ, SUSANNA M

ART UNIT	PAPER NUMBER
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3692

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02/25/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/627,921	Applicant(s) WALLMAN, STEVEN M.H.	
	Examiner Susanna M. Diaz	Art Unit 3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/14/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This final Office action is responsive to Applicant's amendment filed December 6, 2007.

Claims 1-3 have been amended.

Claims 1-3 are pending.

2. The previously pending objection to the specification is withdrawn in response to Applicant's submission of a substitute abstract.

The previously pending rejection under 35 USC 101 is withdrawn in response to Applicant's claim amendments.

Response to Arguments

3. Applicant's arguments with respect to claims 1-3 have been considered but are moot in view of the new grounds of rejection, which are necessitated by Applicant's claim amendments.

Additionally, "Applicants seasonably traverse this assertion of Official Notice and request documentary evidence supporting it." (Page 6 of Applicant's response).

Applicant provides no support for the Official Notice traversal. Examiner notes the following discussion of Official Notice taken from the MPEP:

To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241 ("[I]n the absence of any

demand by appellant for the examiner to produce authority for his statement, we will not consider this contention.”). A general allegation that the claims define a patentable invention without any reference to the examiner’s assertion of official notice would be inadequate. If applicant adequately traverses the examiner’s assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (“[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings” to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2). If applicant does not traverse the examiner’s assertion of official notice or applicant’s traverse is not adequate, the examiner should clearly indicate in the next Office action that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner’s assertion of official notice or that the traverse was inadequate. If the traverse was inadequate, the examiner should include an explanation as to why it was inadequate. (MPEP § 2144.03(C))

Applicant has not “specifically point[ed] out the supposed errors in the examiner’s action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art.” Applicant’s broad request for references to support Examiner’s statements of Official Notice amounts to nothing more than an unsupported challenge. Consequently, the following statements of Official Notice made in the art rejection have been established as admitted prior art due to Applicant’s failure to adequately traverse the Examiner’s assertions of Official Notice:

Official Notice is taken that it was old and well-known in the art of trading at the time of Applicant’s invention to execute a set of trades (or a set of buy/sell transactions)

in response to a user clicking a command to do so (e.g., selecting a trade option with a computer mouse). The use of a computer mouse to execute a computer command provides an easy shortcut for executing such a command.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Lupien et al. (U.S. Patent No. 5,101,353).

[Claim 1] Lupien discloses a computer implemented method using aggregation to enable a user to trade a plurality of market tradable assets or liabilities as part of a single, customizable investment portfolio comprising:

modifying a desired overall characteristic of the single, customizable investment portfolio (col. 3, lines 3-7; col. 10, lines 1-7);

determining automatically, in response to said modifying, a plurality of necessary modifications to the single, customizable investment portfolio so that the single, customizable investment portfolio as modified has the desired overall characteristic (cols. 7-8; col. 10, lines 1-30);

creating an order to modify the single, customizable investment portfolio as a whole (cols. 7-8; col. 10, lines 1-30; col. 11, lines 38-68; col. 12, lines 6-25);

forwarding the trading order including a plurality of trades implementing the plurality of necessary modifications to the existing portfolio (cols. 7-8; col. 10, lines 1-30; col. 11, lines 38-68; col. 12, lines 6-25; col. 14, lines 30-68; col. 15, lines 1-29);

aggregating via computer for each of a plurality of distinct market tradable assets or liabilities within the trading order for the user with one or more trading orders of one or more other users, wherein said aggregating includes combining at least one trading order involving either a single share, an odd lot or a fractional share of said each distinct market tradable asset or liability with other trading orders of said each distinct market tradable asset or liability (cols. 7-8; col. 10, lines 1-30; col. 11, lines 38-68; col. 12, lines 6-25; col. 14, lines 30-68; col. 15, lines 1-29); and

executing one or more trades of each of the distinct market tradable assets or liabilities resulting from said aggregating to implement the order received from the user (cols. 7-8; col. 10, lines 1-30; col. 11, lines 38-68; col. 12, lines 6-25; col. 14, lines 30-68; col. 15, lines 1-29).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lupien et al. (U.S. Patent No. 5,101,353) in view of Official Notice [now admitted prior art].

[Claim 2] Lupien discloses a computer implemented method using aggregation to enable a user to trade a plurality of market tradable assets or liabilities as part of a single, customizable investment portfolio and to rebalance the single, customizable investment portfolio to comply with a user selectable risk/reward characteristic (col. 3, lines 3-7; col. 10, lines 1-7) comprising:

determining a plurality of modifications to make to the single, customizable investment portfolio so that the single, customizable investment portfolio as modified matches the user selectable risk/reward characteristics (col. 3, lines 3-7; cols. 7-8; col. 10, lines 1-30);

creating an order to modify the single, customizable investment portfolio as a whole (cols. 7-8; col. 10, lines 1-30; col. 11, lines 38-68; col. 12, lines 6-25);

transmitting the trading order including a plurality of trades implementing the plurality of necessary modifications to the single, customizable investment portfolio to a central controller over a computer network (cols. 7-8; col. 10, lines 1-30; col. 11, lines 38-68; col. 12, lines 6-25; col. 14, lines 30-68; col. 15, lines 1-29);

aggregating via computer for each of a plurality of distinct market tradable assets or liabilities within the trading order for the user with one or more trading orders of one or more other users, wherein said aggregating includes combining at least one trading order involving either a single share, an odd lot or a fractional share of said each distinct

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market tradable asset or liability with other trading orders of said each distinct market tradable asset or liability (cols. 7-8; col. 10, lines 1-30; col. 11, lines 38-68; col. 12, lines 6-25; col. 14, lines 30-68; col. 15, lines 1-29); and

executing one or more trades of each of the distinct market tradable assets or liabilities resulting from said aggregating to implement the order received from the user (cols. 7-8; col. 10, lines 1-30; col. 11, lines 38-68; col. 12, lines 6-25; col. 14, lines 30-68; col. 15, lines 1-29).

While Lupien's user may execute the trading order with a central controller in conformance with the necessary modifications to the single, customized investment portfolio (as discussed above), Lupien does not expressly disclose that the trading order is transmitted to the central controller in response to a user clicking a command to do so. However, Official Notice is taken that it was old and well-known in the art of trading at the time of Applicant's invention to execute a set of trades (or a set of buy/sell transactions) in response to a user clicking a command to do so (e.g., selecting a trade option with a computer mouse) [now admitted prior art]. The use of a computer mouse to execute a computer command provides an easy shortcut for executing such a command [now admitted prior art]. Since Lupien's system is computer-implemented, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Lupien such that the trading order is transmitted to the central controller in response to a user clicking a command to do so in order to provide an easy shortcut for executing such a command.

[Claim 3] Lupien discloses a method for trading instruments comprising:

selecting a desired characteristic of a desired portfolio of investments (col. 3, lines 3-7; col. 10, lines 1-7);

allocating an investment amount to the plurality of trades to obtain the desired characteristics of the portfolio (col. 3, lines 3-7; cols. 7-8; col. 10, lines 1-30);

transmitting a plurality of trades to a central controller in a single transaction as a portfolio trade (cols. 7-8; col. 10, lines 1-30; col. 11, lines 38-68; col. 12, lines 6-25; col. 14, lines 30-68; col. 15, lines 1-29);

aggregating via computer for each of a plurality of distinct market tradable assets or liabilities within the portfolio trade for the user with one or more trading orders of one or more other users, wherein said aggregating includes combining at least one trading order involving either a single share, an odd lot or a fractional share of said each distinct market tradable asset or liability with other trading orders of said each distinct market tradable asset or liability (cols. 7-8; col. 10, lines 1-30; col. 11, lines 38-68; col. 12, lines 6-25; col. 14, lines 30-68; col. 15, lines 1-29); and

executing one or more trades of each of the distinct market tradable assets or liabilities resulting from said aggregating to implement the order received from the user (cols. 7-8; col. 10, lines 1-30; col. 11, lines 38-68; col. 12, lines 6-25; col. 14, lines 30-68; col. 15, lines 1-29).

While Lupien's user may execute the trading order with a central controller in conformance with the necessary modifications to the single, customized investment

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portfolio (as discussed above), Lupien does not expressly disclose that the trading order is transmitted to the central controller in response to a user clicking a command to do so. However, Official Notice is taken that it was old and well-known in the art of trading at the time of Applicant's invention to execute a set of trades (or a set of buy/sell transactions) in response to a user clicking a command to do so (e.g., selecting a trade option with a computer mouse) [now admitted prior art]. The use of a computer mouse to execute a computer command provides an easy shortcut for executing such a command [now admitted prior art]. Since Lupien's system is computer-implemented, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify Lupien such that the trading order is transmitted to the central controller in response to a user clicking a command to do so in order to provide an easy shortcut for executing such a command.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

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be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-3 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-86 of U.S. Patent No. 6,601,044.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application are fully anticipated by the claims of the patent. Elimination of an element or its functions is deemed to be obvious in light of prior art teachings of at least the recited element or its functions (see *In re Karlson*, 136 USPQ 184, 186; 311 F2d 581 (CCPA 1963)).

10. Claims 1-3 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-37 of U.S. Patent No. 6,996,539.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application are fully anticipated by the claims of the patent. Elimination of an element or its functions is deemed to be obvious in light of prior art teachings of at least the recited element or its functions (see *In re Karlson*, 136 USPQ 184, 186; 311 F2d 581 (CCPA 1963)).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Young et al. (U.S. Patent No. 6,393,409) – Mutually optimizes portfolios for multiple participants.

Hawkins et al. (U.S. Patent No. 5,497,317) – Pools trade orders for funds from various accounts for block execution.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 8 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Susanna M. Diaz/
Primary Examiner, Art Unit 3692
February 19, 2008